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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/017,394	12/18/2001	Kazuhiro Hayashi	Q67780	6473
65565	7590	04/19/2010		
SUGHRUE-265550			EXAMINER	
2100 PENNSYLVANIA AVE. NW			SWEARINGEN, JEFFREY R	
WASHINGTON, DC 20037-3213				
			ART UNIT	PAPER NUMBER
			2445	
			NOTIFICATION DATE	DELIVERY MODE
			04/19/2010	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/017,394

Applicant(s)

HAYASHI ET AL.

Examiner

Jeffrey R. Swearingen

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Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 February 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 29-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 29-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 December 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/GS/US)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/26/10 has been entered.

Response to Arguments

2. Applicant's arguments filed 2/26/10 have been fully considered but they are not persuasive.

3. Applicant argued that Robinson in view of Morohashi failed to disclose *the updated number of plays of each of said pieces of music stored in the terminal-side storage section without the data of pieces of music are sent to the server apparatus*. Morohashi discloses a portable recording and playback apparatus that exchanges musical data between the music server and playback apparatus. Morohashi, column 6, lines 34-53. Morohashi further discloses the exchange of data from an external network to a music server and playback apparatus, where there is additional information associated with musical data, which is separately considered and transmitted from the musical data itself. Morohashi, column 11, lines 3-13. This signifies that the additional information (*updated number of plays of each of said pieces of music*) is transmitted separately from *the data of pieces of music*. If the additional data is transmitted from the music server to the

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internet server separately from the music data, and if the portable music player transmits data from the portable music player to the music server, it would have been obvious to one of ordinary skill in the art at the time of invention that the two types of data are stored in separate data segments, and as such, could be transmitted separately from each other from the portable music player to the music server just as the music server transmits the data separately from the music server to the Internet server.

4. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 29-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Robinson (US 7,072,846) in view of Morohashi (US 7,130,251).

7. In regard to claim 29, Robinson disclosed *a system for storing and playing music, comprising:*

a server apparatus comprising

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a storage section which stores data of pieces of music that a user possesses, and is adapted to store a number of plays of each of said pieces of music, Robinson, column 10, lines 20-24

a reproducing section which plays back said data of pieces of music, music players on their machines, Robinson, column 10, lines 23-24

an updating section that updates a number of plays of each piece of music that is played back, each time said playing back is completed at the ... terminal, and that stores the updated number of plays of each of said pieces of music in the terminal-side storage section; Robinson, column 11, lines 19-25

wherein, if the ... terminal is connected to the server apparatus through the interface, the updated number of plays of each of said pieces of music stored in the terminal-side storage section without the data of pieces of music are sent to the server apparatus, and the server apparatus updates the number of plays of each of said pieces of music stored in the terminal-side storage section.

Robinson, column 11, lines 35-46.

Robinson disclosed the use of MP3, CD and other types of music players on a terminal device. Robinson never explicitly states the music players are portable, or that they can transfer data to and from a server. Robinson failed to disclose *a portable terminal adapted to play back pieces of music while disconnected from the server apparatus, the portable terminal capable of being carried for playing back said data of pieces of music by a user, comprising an interface that receives the data transferred from the transfer section, a terminal-*

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side storage section that stores data received through the interface, or a transfer section that transfers the data.

Morohashi disclosed a system where a portable music player (*a portable terminal adapted to play back pieces of music while disconnected from the server apparatus, the portable terminal capable of being carried for playing back said data of pieces of music by a user, comprising an interface that receives the data transferred from the transfer section, a terminal-side storage section that stores data received through the interface*) and a music server were interconnected for transmitting data. Morohashi, Figure 1. Morohashi disclosed data could be exchanged between the portable music player and the music server (*a transfer section that transfers the data*). Morohashi, column 6, lines 34-53.

Robinson updated the play count to reflect a user's "taste" in listening music. Robinson supported MP3 and CD players. Morohashi exchanged information with portable music players which utilized the MP3 format. (Morohashi, column 5, line 25). Therefore it would have been obvious to one of ordinary skill in the art at the time of invention to incorporate data information collected from a portable music player in Morohashi with the play count feature of Robinson in order to track how often a user listened to a piece of music accurately, including both at a user terminal and a portable device.

8. Claim 30 is a method claim with substantially the same limitations as the system of claim 29.
9. Claim 31 is a portable terminal claim with substantially the same limitations as the system of claim 29.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

11. Katz et al. US 6,560,651

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey R. Swearingen whose telephone number is (571)272-3921. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivek Srivastava can be reached on 571-272-7304. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Jeffrey R. Swearingen
Examiner
Art Unit 2445

/Jeffrey R. Swearingen/
Examiner, Art Unit 2445